

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MELVIN HATCH

Appeal No. 2005-0941
Application No. 09/941,029

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed January 31, 2003) of claims 1 to 7 and 9 to 18, which are all of the claims pending in this application.¹

We AFFIRM-IN-PART.

¹ Claim 8 was canceled subsequent to the final rejection and replaced with new claim 18.

BACKGROUND

The appellant's invention relates to a heat-conducting support for a round or curved bottom vessel, such as a round bottom flask (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief.

Claim 1, the only independent claim on appeal, reads as follows:

A heat-conducting support for a round or curved bottom vessel,
comprising;
a metallic unit having an inner portion, an outer portion, and a base for
placement on a heating element;
wherein said inner portion has no apertures and is concavely curved to
support a vessel having a round or curved bottom;
wherein said outer portion adjoins said inner portion at an upper location
remote from a bottom of said inner portion; and
wherein said outer portion extends away from said upper location of said
inner portion toward said base and merges with said base.

The prior art references of record relied upon by the examiner in rejecting the
appealed claims are:

Spremulli et al. (Spremulli)	1,141,846	June 1, 1915
Golden	1,651,346	Nov. 29, 1927
Emmer	2,285,698	June 9, 1942
Margulies	2,552,051	May 8, 1951
Siegel	2,691,816	Oct. 19, 1954
Wischusen, III	4,726,553	Feb. 23, 1988
Shaw et al. (Shaw)	5,127,188	July 7, 1992

Claims 1, 4, 6, 7, 11 to 13 and 15 to 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Golden.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Shaw.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Siegel.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Emmer.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Margulies.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Wischusen.

Claims 1, 4, 6, 7, 11 to 13 and 15 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Spremulli.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Spremulli and Shaw.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Spremulli and Siegel.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Spremulli and Emmer.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Spremulli and Margulies.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Golden in view of Spremulli and Wischusen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed January 23, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 31, 2003) and reply brief (filed March 29, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In the grouping of the claims section of the brief (p. 4), the appellant grouped the rejected claims as follows:

- a) Claims 1-4, 6, 7, 12-18, which stand or fall together;
- b) Claim 5;
- c) Claim 9;
- d) Claim 10; and
- e) Claim 11.

In accordance with the appellant's grouping of claims and arguments provided, we need to review only the rejections of claims 1, 5 and 9 to 11 to decide the appeal on the rejections set forth above.

The anticipation rejection of claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Golden's invention is directed to apparatus for the sterilization of dental instruments, barbers' tools, and the like, through the submersion of the instruments in a cold sterilizing solution contained within the apparatus. As shown in Figures 1-3, a circular metal base 1 having a circular recess 2 in its upper wall receives a circular glass jar 3 and supports the same against displacement. The jar 3 is intended to contain a sterilizing solution for the cold sterilization of dental instruments, barbers' razors, scissors, combs, and other tools, as illustrated in Figure 2.

The appellant argues that claim 1 is not anticipated by Golden for the following three reasons. First, Golden does not disclose a heat-conducting support. Second, Golden does not disclose a base for placement on a heating element. Lastly, Golden does not disclose an inner portion which is concavely curved to support a vessel having a round or curved bottom. We find these arguments unpersuasive for the reasons which follow.

Golden does disclose a heat-conducting support. Golden's base 1 is made of metal which inherently is capable of conducting heat. In view of this inherent heat-conducting property of metal, Golden's base 1 is a heat-conducting support.

Golden does not disclose placing base 1 on a heating element. However, Golden's base 1 is capable of being placed on a heating element. We view the language of claim 1 (i.e., a base for placement on a heating element) as reciting only an intended use of the base. As such, the heating element is not part of the claimed structure. The manner or method in which an apparatus is to be utilized is not germane to the issue of patentability of the machine itself. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962).

Golden does disclose an inner portion which is concavely curved to support a vessel having a round or curved bottom. Figures 2 and 3 of Golden clearly show that circular recess 2 of base 1 includes a concavely curved rounded corner adjacent the bottom corner of the jar 3. In addition, circular recess 2 of base 1 is concavely curved in a horizontal plane since it accepts the round bottom of the circular jar 3. Thus, the claimed inner portion which is concavely curved to support a vessel having a round or curved bottom is readable on either (1) the concavely curved rounded corner of Golden's circular recess 2 of base 1; or (2) the circular recess 2 of base 1 which is concavely curved in a horizontal plane.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

The obviousness rejection of claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

Golden teaches all the limitations of claim 1. Affirmance of the 35 U.S.C. § 103 rejection is appropriate, since it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220

USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

The appellant's only argument against his ground of rejection is that Spremulli is non-analogous art. We do not agree.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

In this case, Spremulli is from the same field of endeavor. The appellant's field of endeavor is a heat-conducting support. Spremulli's field of endeavor is also a

heat-conducting support since the stand 3 is made of metal (see the cross hatching of the stand in Figure 1), which inherently conducts heat.²

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

The obviousness rejections of claim 5

We will not sustain the rejections of claim 5 under 35 U.S.C. § 103.

Claim 5 adds to parent claim 1 the further limitation that "at least one of said inner portion, said outer portion, and said base comprises a multi-layer sheet of metal."

Clearly, this limitation of claim 5 is not taught or suggested by Golden. To account for this deficiency in Golden, the examiner turns to Siegel. While Siegel does teach a composite multi-layered sheet metal of a "low quality" precious or rare metal layered onto a base metal, we find no teaching or suggestion in the applied prior art of applying this multi-layered sheet metal to Golden's metal base 1. In our view, the only suggestion for modifying Golden in the manner proposed by the examiner to arrive at

² It appears that the metal stand 3 of Spremulli may well anticipate claim 1.

the subject matter of claim 5 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claim 5 is reversed.

The obviousness rejections of claim 9

We sustain the rejections of claim 9 under 35 U.S.C. § 103.

The appellant's only argument against the rejection of claim 9 is that Emmer is non-analogous art. We do not agree.

In this case, Emmer is from the same field of endeavor. The appellant's field of endeavor is a heat-conducting support. Emmer's field of endeavor is also a heat-conducting support since the metal plate 10 inherently conducts heat.

For the reasons set forth above, the decision of the examiner to reject claim 9 under 35 U.S.C. § 103 is affirmed.

The obviousness rejections of claim 10

We sustain the rejections of claim 10 under 35 U.S.C. § 103.

The appellant's only argument against the rejection of claim 10 is that Margulies is non-analogous art. We do not agree.

In this case, Margulies is from the same field of endeavor. The appellant's field of endeavor is a heat-conducting support. Margulies' field of endeavor is also a heat-conducting support since the metal plate 10 inherently conducts heat.

For the reasons set forth above, the decision of the examiner to reject claim 10 under 35 U.S.C. § 103 is affirmed.

The anticipation and obviousness rejections of claim 11

We sustain the rejection of claim 11 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103.

Claim 11 adds to parent claim 1 the further limitation that "said base extends radially outwardly from where said outer portion merges with said base."

The appellant argues that Golden does not teach a base that "extends radially outwardly from where said outer portion merges with said base." We do not agree. As clearly shown in Figures 1-3 of Golden, the circular metal base 1 includes a rounded edge which extends radially outwardly from the sidewall and then turns inwardly and upwardly to form a bottom. In our view, the claimed base that "extends radially outwardly from where said outer portion merges with said base" is readable on the rounded edge of Golden's base 1 since that rounded edge does extend radially outwardly from the sidewall.

For the reasons set forth above, the decision of the examiner to reject claim 11 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 is affirmed.

Claims 2 to 4, 6, 7 and 12 to 18

As set forth above, the appellant has grouped claims 1 to 4, 6, 7 and 12 to 18 as standing or falling together. Accordingly, in view of our affirmance of the rejections of claim 1 above, claims 2 to 4, 6, 7 and 12 to 18 fall with claim 1. Thus, it follows that the

decision of the examiner to reject claims 4, 6, 7, 11 to 13 and 15 to 18 under 35 U.S.C. § 102(b) and claims 2 to 4, 6, 7 and 12 to 18 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4, 6, 7, 11 to 13 and 15 to 18 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 is affirmed; the decision of the examiner to reject claims 2, 3, 9, 10 and 14 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

John P. McQuade
JOHN P. McQUADE
Administrative Patent Judge

Jeffrey V. Nase
JEFFREY V. NASE
Administrative Patent Judge

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ROBERT W. BECKER & ASSOCIATES
707 HIGHWAY 66 EAST
SUITE B
TIJERAS , NM 87059

JVN/jrg